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HOFFMAN WARNICK & D'ALESSANDRO, LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER

BROOKS, MATTHEW L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/884,095	Applicant(s) BLOCHER ET AL.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because pg 19, line 16 "As state above...". Correction is required. See MPEP § 608.01(b).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hypertext link" in the template must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-30** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Or alternatively, Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The omitted steps/indefiniteness are: for purposes of this example only in Claims 1-6 are explained in detail.

Examiner looks to Claim 1 wherein in step (a) a business process is provided and in step (b) *risks are identified* as control points, then in step (c) arranging information pertaining to the control points using a template wherein the information comprises tests and the tests identify risks. However, the risks have already been identified in step (b) and there is no mention/step of a performing of tests to identify the risks, only that the risks are identified.

Likely there should be a step between (a) and (b) because it appears the Applicant is first performing tests to id the risk then id risks as control point.

Further still although Examiner is fully aware of the definition of tests and test entity Applicant is non-consistent use of the term is bordering on

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indefiniteness and Examiner reserves the right to make further objections/rejections upon submission of Applicant's response. For purposes of Examination the term "test" will mean exactly what the Applicant defines it as on page 8 of specification, "a measure taken to address an identified risk"

Appropriate action is required.

5. **Claims 4-6, 8**, provides for the use of "template information", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 4-6, 8** is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

8. **Claims 19-28** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "Template" just as is a

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pattern on a piece of paper and/or a contract between two or more persons is non-patentable subject matter.

9. Furthermore during the examination of the claims Examiner gives the use of the template and the fields there on little patentable weight so long as the prior art shows 1) providing a business process 2) id the risks and 3) arranging information pertaining to risks on a template. See below.

APPARATUS CLAIMS MUST BE STRUCTUR-ALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir.)

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-29** are rejected under 35 U.S.C. 102(b) as being clearly anticipated and taught by the public activities of Keane Inc. as of May 5th, 2000 as shown by their web Homepage as of said date and “PRAM it or walk away”; Gray, Neal; Transactions of AACE International; pp: r5-48; 1998. (PRAM)

12. With respect to **Claim 1 and 7, 8, 9 and 10**: PRAM discloses

A computer implemented method for reviewing a business process to identify and address risks, comprising the step of:

providing a business process {see whole document};

identifying risks in the business process as control points {see pg A, iv and v; and pg B, v as soon as the risks are identified and placed on a template they become control points; ie see D, figure 3; this is further supported by the definition of “control point as known in the art and Applicant’s definition found on pg 8, “Control Point” – a risk identified in a business process that should be addressed”}; and

arranging information pertaining to the control points (this is the equivalent to arranging information pertaining to the risks such as what they are and how to mitigate) in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify risks in the business process. {pg D, fig 3 Keane is a consultant/auditor/test entity which conducts tests and consults/audits companies

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risks and how to address them via an “e-solutions strategy”/action entity and thus implemented on a computer and audits using a template}.

13. With respect to **Claim 2 and 9**: PRAM discloses

identifying actions to address the risks {See fig. 3, 2 “Risk Mitigation Action”};

arranging the identified actions in the template {See fig 3, Risk Profile};
and

performing an audit using the template {see whole document, the reason why a user would create a “risk profile” is to perform and audit, this too is where the step of accessing the template occurs, see also pg B, v; “If there isn’t a template, begin making one so that the next time you, or someone else, needs to identify risks you wont have to start from scratch” This is the same as storing a template in a data base to later use/access again.}.

14. With respect to **Claim 3**: PRAM discloses

step of identifying risks comprises the step of implementing a set of tests to identify risks in the business process {pg B, v and vi; “Identify Risks” and “Determine Probability and Consequence”}.

15. With respect to **Claim 4**: PRAM discloses

(NOTE: As for claim 4, the information on the template is considered to be non-functional descriptive data, see above)

a set of tests, wherein the set of tests identify risks in the business process {fig 3}; and

a set of actions, wherein the set of actions address the risks (fig 3).

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16. With respect to **Claim 5**: PRAM discloses

(NOTE: As for claim 5, the information on the template is considered to be non-functional descriptive data, see above)

a business process {See PRAM};

a test entity, wherein the test entity performs the set of tests {See fig 3 and whole document};

an action entity, wherein the action entity performs the set of actions; and audit details {See fig 3 and whole document}.

17. With respect to **Claim 6**: PRAM discloses

(NOTE: As for claim 6, the information on the template is considered to be non-functional descriptive data, see above)

a control point name {pg D, fig 3};

control point revisions { pg D, fig 3};

background information { pg D, fig 3}; and

a control point frequency { pg D, fig 3}.

18. **Claims 10-29** (system, program, method, template) recite the same limitations already discussed above and are rejected on the same analysis.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

21. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

22. Claims 1-30 rejected under 35 U.S.C. 103(a) as being unpatentable over PRAM in further view of Official Notice.

Claims 1-30 are rejected under 35 U.S.C. 103 as being unpatentable over the PRAM reference. The PRAM reference discloses all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (ie; id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed. In determining the obviousness of applying what is generally known in the risk consulting industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to

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access and download files from another computer located at a different site than the first. Using a hypertext link to access such information is widely known by the use of html and linking techniques. Also, the risk consulting industry has utilized computers for years to keep track of accounts and present this data to their customers and employees through GUI's. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in one's template/risk profile in a typical risk analysis system such as that taught in the PRAM reference for the purpose of obtaining/editing information. The desirability to do this is clearly to save a customer/employee the time of having to work on paper and pull the template/risk profile each time a user would want to view and or edit the account information; reduce operational costs through more effective information delivery; and improve compliance checking capability.

Response to Arguments

23. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. A printout of KEANE's homepage as pulled from the www.archive.org with a 102 (b) date showing Keane was up and running on the web "e-solutions"

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B. Patent No. 6,591,289 merely one reference showing the use of template shared over network was well known in the art.

C. Professional's Handbook of Financial Risk Management, Lev Borodorsky, Business and Economics 2000, 832 pages; showing defining data requirements that show operational risk exposure as control points was well known, some relevant pages attached herein.

D. Auditing systems: 5 Star at Merck Sharp and Dohme, James, Phil, (attached)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
5/10/2006



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600